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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q75737

Jean-Pierre BONICEL

Appln. No.: 10/611,946

Group Art Unit: 2883

Confirmation No.: 5418

Examiner: Eric K. WONG

Filed: July 3, 2003

For: CABLE HAVING A SUBSTANTIALLY GASTIGHT METAL TUBE RECEIVING AT
LEAST ONE OPTICAL CONDUCTOR AND A HYDROGEN-ABSORBENT
SUBSTANCE

RESPONSE UNDER 37 C.F.R. § 1.111

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated June 30, 2005, please reconsider the above-identified application as follows.

Claims 14-20 are all the claims pending in the application. Claims 1-13 are withdrawn from consideration. The Examiner has acknowledged that Applicant's Response filed April 11, 2005 is persuasive. Claims 14-20 are now rejected under 35 U.S.C. 103(a) as being unpatentable over Secco et al. (U.S. Pat. No. 4,741,592 [hereinafter "Secco"]) in view of Hollander (U.S. Pat. No. 5,111,002).

One would not have been motivated to combine the teachings of Secco and Hollander to derive the claimed features. It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).) The Federal Circuit has also emphasized that particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components or the prior art for combination in the manner claimed. (See *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000)).

Applicant takes this opportunity to explain why one would not combine the teachings of Secco and Hollander. More specifically, Secco relates to a hydrogen absorbent composition for protecting optical fibers from damage due to hydrogen. The grounds of rejection acknowledge that Secco fails to disclose the step of forming a metal strip into a tube, as recited in claims 14 and 15.

Hollander is cited for teaching to roll a strip of metal to form a thermocouple. (See Figures 1-4 of Hollander.) However, Hollander does not disclose an optical fiber cable, let alone a hydrogen absorbing composition.

The references do not disclose any desirability for combining their teachings and, moreover, respectively relate to different technical fields, i.e., 1) the field of optical fiber cables in Secco; and 2) the field of thermocouples in Hollander. As one skilled in the art will appreciate, thermocouples have different physical requirements than those required for optical fiber cables, such that procedures used for one would not be readily accepted for use with the other. The mere disclosure of both references using a metal tube is not sufficient to meet the required obviousness standard. Clearly, not all metal tube encased materials are prepared in the same manner with disregard to the particular elements contained therein. Therefore, one skilled

in the art would not combine the teachings of Secco and Hollander without some suggestion or motivation to do so, which is clearly absent in the present case.

Moreover, even if one were to combine the applied art, *arguendo*, each feature of claims 14 and 15 would not be taught or suggested because neither Hollander nor Secco disclose a step of covering an inside surface of a strip of metal with a catalyst substance. Instead, Secco teaches to mix together a filler material and a hydrogen absorbing composition, comprising the catalyst. A problem with Secco's method is that the catalyst (i.e. charcoal powder) cannot be uniformly mixed with the filler material (i.e. unsaturated polymer) because of compatibility problems resulting with a nonuniform distribution of the catalyst throughout the absorbent hydrogen composition.

This problem is solved by the inventions of claims 14 and 15, which cover an inside surface of a strip of metal with a catalyst substance. Then, as particularly recited in claim 14, a tube is formed in which filler material is inserted. Also, as recited in claim 15, the catalyst substance is covered with a hydrogen-absorbent substance. The present method, in contrast to the method according to Secco, leads to a uniform distribution of the catalyst on the inside surface of the tube.

The present specification even acknowledges differences between features of claims 15 and 17, and the prior art, by observing that although the specific surface area of the catalyst in contact with the hydrogen-absorbent substance is smaller than a corresponding surface area when the catalyst is mixed with the filler material (as in Secco), the hydrogen absorbing effect remains satisfactory. (See section [0013] of the Published Application (US 2004/0008440 A1).)

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Therefore, based on the above, it is submitted that one would not have combined Secco and Hollander to obtain the features of claims 14 and 15, and even if such a combination were made, *arguendo*, each of the claimed features would not be taught or suggested. Claims 16-20 are deemed patentable over the references at least due to their respective dependencies on claims 14 and 15.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

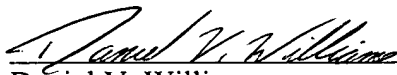
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER


Daniel V. Williams
Registration No. 45,221

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